

REMARKS

This responds to the Office Action mailed on March 5, 2009.

Claims 1-6, 9-11, 13, and 16-21 are amended, claims 7, 8, 14 and 15 are canceled, and claims 22-25 are added; as a result, claims 1-6, 9-13, and 16-25 are now pending in this application.

§ 101 Rejection of the Claims

Claim 16 was rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicant amends claim 16 to recite a “computer-readable medium for storing a set of instructions” per the Examiner’s suggestion. This amendment is supported by Applicant’s originally filed specification, paragraph 132. Applicant respectfully submits that amended claim 16 is directed to statutory subject matter, and respectfully requests withdrawal of the rejection.

Applicant respectfully notes that on page 3 of the Office Action, the Examiner has identified “claim 28” as rejected under 35 USC §101. Applicant understands this rejection as directed to claim 16, and requests clarification and correction if such understanding is not correct.

§ 102 Rejection of the Claims

Claims 1-10, 13-18, 20 and 21 were rejected under 35 U.S.C. § 102(e) as being anticipated by Kelts (U.S. 7,139,983). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.¹

Applicant has amended claim 1 to include the limitations of original claims 7 and 8, specifically to recite “selectively communicating digital content associated with the at least one available content identifier to the content destination independently of a content distributor, wherein the plurality of content provider identifiers are included in a communication between the

¹ *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

content distributor and the content destination.” Similar amendments are made to independent claims 16, 17 and 21.

The Kelts reference discusses an interactive content guide for television programming,² but does not disclose a method as recited in Applicant’s amended claim 1. Applicant respectfully disagrees with the Examiner’s characterization of the filtering techniques of Kelts as teaching “selectively communicating digital content associated with the at least one available content identifier to the content destination independently of a content distributor,” as recited in Applicant’s claim. The system of Kelts merely organizes programming data in an easy-to-use manner by moving or hiding selection items before presentation.³ In the system of Kelts, the selection items may be filtered by the navigation interface display system before presentation.⁴ Kelts does not teach a method or system to selectively communicate digital content associated with a content identifier independently of a content distributor, wherein a plurality of content provider identifiers are included in a communication between the content distributor and the content destination, as recited in Applicant’s claims. Therefore, Kelts fails to disclose each and every element of the amended claims.

Since the independent claims have been amended to include recitations from previously and currently pending dependent claims, no new issues are raised by this amendment as they have already been considered by the Examiner. Accordingly, Applicant believes that the issuance of a Final Office Action should not result from this amendment to the claims.

As each and every element as set forth in the claims is not found in a single prior art reference, amended claims 1, 16, 17 and 21, as well as the claims depending thereon, are patentable over the applied reference. Applicant respectfully requests withdrawal of the rejection of these claims.

² Kelts, col. 4, lines 14-26.

³ Kelts, Abstract, col. 21, lines 32-46 and 54-58.

⁴ Ibid.

§ 103 Rejection of the Claims

Claims 11, 12, and 19 were rejected under 35 U.S.C. § 103(a) as being obvious over Kelts in view of Alonso et al. (U.S. 6,184,878; hereinafter "Alonso").

To establish a prima facie case of obviousness under 35 U.S.C. §103, the prior art reference (or references when combined) must teach or suggest every limitation of the claim.⁵ The asserted combination of Kelts in view of Alonso fails to teach or suggest all of the claim limitations present in claims 11, 12, and 19, as amended. Specifically, as detailed with respect to claim 1 above, Kelts does not teach a method or system to selectively communicate digital content associated with a content identifier independently of a content distributor, wherein a plurality of content provider identifiers are included in a communication between the content distributor and the content destination, as recited in Applicant's claim 1. The Alonso reference fails to satisfy the deficiencies of Kelts, and therefore the applied references do not teach or suggest every limitation of claims 11 and 12.

Further, the applied references fail to teach or suggest a substantially similar limitation in amended claim 17, on which claim 19 depends. Therefore, the applied references do not teach or suggest every limitation of claim 19.

Applicant submits that claims 11, 12 and 19 are patentable over the applied references, and respectfully requests reconsideration and withdrawal of these rejections.

New Claims

Applicant adds new claims 22-25, support for which is provided in Applicant's originally filed specification and figures, at least at paragraphs 50-53, 66- 71 and Figures 4 and 7. These claims recite substantially similar limitations to those of amended claim 1, and therefore, the applied references fail to teach each and every limitation of claims 22-25. Applicant submits that new claims 22-25 are patentable over the applied references, and respectfully requests consideration and allowance of the new claims.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's representative at (206) 420-2534 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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Date August 5, 2009

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CERTIFICATE UNDER 37 CFR 1.18: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 5th day of August, 2009.

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